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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,439	04/13/2004	Volkmar Teichgraber	30882/DP016	4835
4743 7590 06/18/2009 MARSHALL, GERSTEIN & BORUN LLP 233 SOUTH WACKER DRIVE 6300 SEARS TOWER CHICAGO, IL 60606-6357			EXAMINER JABR, FADEY S	
			ART UNIT 3628	PAPER NUMBER
			MAIL DATE 06/18/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/823,439

Applicant(s)

TEICHGRABER ET AL.

Examiner

FADEY S. JABR

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 13-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 26 February 2009 has been entered.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims **1-12**, drawn to a method and system of capturing data from a mailpiece and applying an identification code to the mailpiece, classified in class 705, subclass 1.
 - II. Claims **13-20**, drawn to a method of applying a target code the mailpiece, classified in class 705, subclass 1.

Newly amended claim **13-20**, are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility such as applying a machine-readable identification code to the mailpiece. Subcombination II has separate utility such as applying a

target code on the mailpiece to verify correct application onto the mailpiece. See MPEP § 806.05(d).

4. The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

5. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 13-20 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP, 821.03. Applicant is respectfully requested to cancel the non-elected claims in response to this office action.

Status of Claims

Claims **11-20** have been newly added. Claims **1-3, 6** and **9-10** have been amended. Claims **13-20** have been Restricted by Original Presentation. Claims **1-12** are pending and are presented for examination.

Response to Arguments

6. Applicant's arguments filed 1 May 2009, with respect to the 35 U.S.C. 101 rejection of claims 1-8 have been fully considered but they are not persuasive. Applicant argues that the newly amended claim now positively recites the statutory class of machines. However, Examiner notes that the statutory class of machines is not being positively recited. The amendment fails to recite which system is performing the critical steps recited in claim 1. For example, the claim fails to recite which system is automatically selecting the new address information. Further, the transformation of the mailpiece (i.e. applying new information) is mere insignificant post-solution activity. Thus, the 101 rejection is upheld.
7. Applicant's arguments with respect to claims 1 and 9 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:
- Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
9. Claims 1-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-8 are directed to a series of steps. In order for a series of steps to be considered a proper process under § 101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). Thus, to qualify as patent eligible, these processes should positively recite the other statutory class to which it is tied

(e.g., by identifying the apparatus the accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g., by identifying the product or material that is changed to a different state). Claims 1-8 identify neither the apparatus performing the recited steps nor any transformation of underlying materials, and accordingly are directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allport et al., U.S. Patent No. 6,865,561 B1 (Cited in PTO-892 mailed 27 June 2007) in view of Avant, U.S. Patent No. 6,976,621 B1, hereinafter referred to as Allport and Avant, respectively.

As per Claims 1 and 9, Allport discloses a method and system comprising:

- detecting address information present on at least one surface of a mailpiece and applying a machine-readable identification code onto the mailpieces after detecting the address information, the machine-readable identification code uniquely identifying the mailpiece (C. 2, lines 8-25);

Allport fails to disclose that the applying is done at a *sorting station*. However, Avant teaches the present invention relates to apparatus and methods for identifying and processing mail. More

particularly, the present invention relates to apparatus and methods for using an identification code on a mailpiece as a redundant source of identification for identifying and processing the mailpiece in a mail sorting system (C. 3, lines 29-34). Thus, Allport teaches scanning address information from a mailpiece and applying a machine-readable code onto the mailpiece, while Avant teaches applying a machine-readable code in a sorting system.

Allport fails to disclose *transmitting the detected address information and the machine-readable identification code to an interface computer and storing the detected address information and the machine-readable identification code in memory of the interface computer; accessing the stored detected address information and the stored machine-readable identification code*. Allport discloses the scanning may be an OCR scan of the recipient address printed on the mailpiece. Therefore the scanned information would have to be stored in a memory location. Further, Avant teaches If ISS 502 successfully resolves the ZIP code portion of destination address 200, ISS 502 then also sprays POSTNET code 202 corresponding to destination address 200 onto the front of mailpiece 100, for example, using nonfluorescent ink. Once RBCS 500 has affixed ID Tag 204 and POSTNET code 202 to mailpiece 100, ISS 502 then sends the POSTNET code information from POSTNET code 202 and the ID Tag information from ID Tag 204 to Image Control Unit (ICU) 508, where the POSTNET code information from POSTNET code 202 and the ID Tag information from ID Tag 204 is stored in Decision Storage Unit (DSU) 514...ICU 508 receives delivery address data from a Central Database 510 and forwards the data along with the mailpiece image, including ID Tag 204, to a Remote Computer Reader (RCR) 512 (C. 7, line 65 - C. 8, line 67, C. 9, lines 7-35). Thus, Avant teaches storing the address and ID data in a storage unit, where it can be accessed at a later time.

- comparing the detected address information with address information present in a plurality of sources of a database (C. 2, lines 48-49, C. 3, lines 39-41, C. 4, lines 15-20);
- automatically selecting new address information from the address information in the database when the stored detected address information does not match address information in the database, the new address information being selected by searching the database for new address information that is most similar to the detected address information (C. 2, lines 39-54);
- detecting a second time, the machine-readable identification code on the mailpiece to re-identify the mailpiece and ensure that the new address information is applied onto the correct mailpiece (C. 2, lines 16-27).

Allport fails to disclose sorting the mailpieces mechanically to match actual sequence of delivery. However, Avant teaches the majority of conventional mechanical processing systems sort each mailpiece based on a special code, such as, a ZIP code or a bar code (i.e., a POSTNET code). Further, Avant teaches Common Sorter Software 1602 can be used with a Mail Processing Bar Code Sorter (MPBCS) 1802, a Downstream Bar Code Sorter (DBCS) 1804, a Carrier Sequence Bar Code Sorter (CSBCS) 1806, an Output Subsystem/Bar Code Sorter (OSS/BCS) 1808, or any other type of Bar Code Sorter. (C. 1, line 54 – C. 2, line 6, C. 19, lines 19-27). Thus, Avant teaches the use of a sorter to process mail in a sequence for carrier delivery.

It would have been obvious to one of ordinary skill in the art at the time of the invention to include applying a code onto a mailpiece at a sorting system and storing address data for later access as taught by Avant in the system of Allport, since the claimed invention is merely a

combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per **Claim 3**, Allport discloses ascertaining whether the detected address information contains a first postal code, and converting the first postal code into a postal code that matches the new address information by comparing the first postal code to a list of new postal codes contained in a conversion file (C. 2, lines 41-54, C. 4, lines 15-20).

As per **Claim 4**, Allport discloses applying the new address information onto the mailpiece in coded form (C. 2, lines 41-54, C. 4, lines 15-20).

As per **Claim 5**, Allport discloses wherein the address information comprises a barcode (C. 2, lines 41-54, C. 4, lines 15-20).

As per **Claim 6**, Allport discloses wherein the address is at least partially plain text (C. 2, lines 16-27).

As per **Claim 8**, Allport fails to disclose transporting the mailpieces at least over a segment as a function of the new address information. However, Avant teaches the present invention relates to apparatus and methods for identifying and processing mail. More particularly, the present invention relates to apparatus and methods for using an identification

code on a mailpiece as a redundant source of identification for identifying and processing the mailpiece in a mail sorting system (C. 3, lines 29-34). Thus, Allport teaches scanning address information from a mailpiece and applying a machine-readable code onto the mailpiece, while Avant teaches applying a machine-readable code in a sorting system.

It would have been obvious to one of ordinary skill in the art at the time of the invention to include using a mail sorting system to transport mail as taught by Avant in the system of Allport, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per **Claim 10**, Allport discloses wherein the first detection device and the first printer are both locating at the sorting system (C. 7, line 51 - C. 8, line 9).

As per **Claim 11**, Allport discloses wherein the first detection device and the second detection device are a single detection device (C. 2, lines 41-54).

As per **Claim 12**, Allport discloses wherein the first printer and the second printer are a single device (C. 3, lines 33-46).

12. Claims 2 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allport in view of Avant as applied to claim 1 above, and further in view of Didriksen, International Publication No. WO 00/00300, hereinafter referred to as Didriksen.

As per Claims 2 and 7, Allport discloses detecting the address information present on the surface of the mailpiece and converting the address information present on the mailpiece into the new address information (C. 2, lines 8-25). Allport fails to disclose processing the mailpieces according to a *two-stage process*. Avant also discloses a mail sorting system (C. 3, lines 29-34). Further, Didriksen teaches a sortation sequence may be used at the first and/or at the second item processing installation as well as in distributing of items and during final delivery of items at the respective destination locations (pp. 10, lines 15-26, pg. 15, lines 16-25, pp. 28, lines 4-22). Thus, Allport discloses the use of detecting address information on a mailpiece; Avant teaches the use of a mail sorting system; and Didriksen teaches multiple sorting sequences.

It would have been obvious to one of ordinary skill in the art to include in the mailing system of Allport and Avant the ability to further sort mail items as taught by Didriksen since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references

in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FADEY S. JABR whose telephone number is (571)272-1516. The examiner can normally be reached on Mon. - Fri. 8:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fadey S Jabr
Examiner
Art Unit 3628

FSJ

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/F. S. J./

Examiner, Art Unit 3628

/John W Hayes/

Supervisory Patent Examiner, Art Unit 3628